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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/077,914 06/04/98 DIETRICH K MO4805LEA314

IM62/0201

EXAMINER

PATENT DEPARTMENT
BAYER CORPORATION
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FOELAK, M

ART UNIT

PAPER NUMBER

1711

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UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No.12

Application Number: 09/077,914

Filing Date: June 4, 1998

Appellant(s): Dieterich et al

Ms. Lyndanne M. Whalen
For Appellant

FEB 01 2000

CDR 12-100

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed Nov.22, 1999.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

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The statement of the status of the claims contained in the brief is not correct. The following is the correct status of the claims in the case.

Claims 11-15, 18 and 21 are rejected under 35 U.S.C. 103(a) as unpatentable over De Vos et al '101

Claims 19, 20, 22 and 23 are rejected under 35 U.S.C. 102(b) as unpatentable over De Vos et al '101.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: The claimed "aromatic amine initiated polyol" called for in the instant claims which is used in the reaction with the claimed polyisocyanate in the presence of cyclopentane optionally mixed with a co-blowing agent to produce a polyurethane foam is clearly taught as one of the polyols that can be used in De Vos et al '101 (col.5, lines 33-36,40, 45 and 46).

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). Attention is invited to the fact

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that the groups set forth by appellants are of similar subject matter but of different scope and are reject over the same reference but under different paragraphs of 35 USC .for similar reasons.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,444,101 De Vos et al 8/1995

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-15, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Vos et al.'101

Patentees disclose making a polyurethane resin which comprises reacting a polyol such as an aromatic amine initiated polyol (col. 5 lines 33-36,40, 45 and 46) with a polyisocyanate

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(col. 5 line 11 et.seq.) In the presence of a blowing agent which comprises cyclopentane and a co-blowing agent such as alkanes and particularly butane and propane are preferred (col. 2 lines 40-50). Attention is invited to the fact that the claimed proportions of the blowing agents read on the broad proportions called for in col. 2 first full par. One skilled in the art being abreast of patentees especially preferred use of alkanes as their co-blowing agents and since patentees have selected of particular importance the claimed polyol and the claimed blowing agent all in the claimed proportions, would certainly have the motivation to make the claimed polyurethane foam..

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19, 20, 22 and 23 are rejected under 35 U.S.C. 102(b) as being substantially met by De Vos et al '101

The instant claims are directed to blowing agent mixture comprising a major amount of cyclopentane and a minor amount of a C₃ and/or C₄ alkane. The applied reference discloses a blowing agent mixture of a major amount of cyclopentane (col. 2 line 10 et.seq.) and a minor amount of especially preferred alkanes such as propane and butane (col. 2 lines 40-49).

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(11) Response to Argument

Appellants urge that the claimed co-blowing agents are among 68 compounds disclosed by patentees as possible co-blowing agents that can successfully be used with cyclopentane in making their polyurethane foams and that there would be too much picking and choosing to do to arrive at using their two species of alkanes to arrive at getting the unexpected results obtained in the instant case. However, beginning with line 40 of col. 7 and 8 of the reference the working examples all use isopentane as the co-blowing agent along with cyclopentane. It is the opinion of the examiner that of all the choices set out in the disclosure of co-blowing agents utilized by one skilled in the art from the aforesaid evidence that a *prima facie* presumption of unpatentability would be created as to the claimed co-blowing agents, especially in view of the fact that appellants have had ample opportunity to show by way of factual objective evidence that isopentane does not achieve the unexpected results that the homologous claimed co-blowing agents achieve. Appellants' arguments with regard the solubility problems of alkanes in polyols would discourage ones skilled the art to use them does not appear to have discouraged patentees from their use in their working examples wherein acceptable results were obtained.

With regard to claims 19-23 the fact patentees do disclose the use of the claimed co-blowing agents in admixture with cyclopentane and that these alkanes are "especially preferred" the and working examples utilize their use clearly lowers the choice of the different classes of co-blowing agents to that of the claimed alkanes..

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

M.F.
Jan. 21, 2000



A handwritten signature in black ink, appearing to read "MORTON FOELAK".

**MORTON FOELAK
PRIMARY EXAMINER**